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S.R.

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/121,300 07/23/98 KANIA

B 3295-0024-00

| EXAMINER |
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022850 QM12/0112
OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT
FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON VA 22202

| WILLSE, D. ART UNIT | PAPER NUMBER |
|------------------------|--------------|
|------------------------|--------------|

3738
DATE MAILED:

#18

01/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.
09/121,300

Applicant(s)

KANIA

Examiner

Dave Willse

Group Art Unit

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☒ Responsive to communication(s) filed on Nov 6, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 75-82 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 75-82 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 17

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 81-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ihle et al., DE 43 21 182 C1. To mold the docking means 7 to the fabric 11 with silicone or the like would have been obvious from the fact the knitted stocking has a silicone sleeve 8. (Note: A German translator was consulted, and it was learned that the silicone sleeve 8 extends to the hole 6 and is in fact attached to the docking means 7. Silicone material at least partially molded to the knitted section 11 and integrated with the sleeve 8 would thus have been obvious, if not inherent, in order to improve the attachment of the docking means 7).

Claims 75-80 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wilson et al., WO 94/24965. The polymeric cushioning material thickness profile is defined by the padded end portion 9 and the silicone portion of the sock 7 (page 7, lines 7-11).

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Claims 81-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al., WO 94/24965. Attaching the serrated post portion 13 to the end of the sock 7 (page 7, lines 12-13) by using some sort of molding process would have been obvious from and motivated by the fact that the padded portion 9 is apparently molded to conform to the distal ends of the sock and the residual limb, with one of ordinary skill having been left to devise an appropriate securement method.

Claims 75-78 and 80 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by LPRI, SU 1739990 A1.

The following claim rejections are based upon the assumption that the SILOPAD SILOSHEATH product was manufactured prior to the effective date of the present invention. The examiner awaits any further information which the Applicant can provide on this matter. However, it is noted that both the "short distal" #1240 model (presented during the prosecution of parent application serial no. 08/611,306) and #12155 model (newly submitted in the Information Disclosure Statement of November 6, 2000), appear to possess all the features described below. Therefore, although the Applicant seems to question whether item #12155 was manufactured prior to effective date of the instant invention, the "short distal" version bears an older designation number (#1240) and is thus believed to qualify as prior art under 35 U.S.C. 102(b).

Claims 75-78 and 80 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by SILOPAD SILOSHEATH. The models submitted are observed to have distal regions of silicone

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cushioning material that are thick relative to middle regions, with the most proximal regions lacking a silicone coating so as to define a recess Achilles configuration.

Claim 79 is rejected under 35 U.S.C. 103(a) as being unpatentable over SILOPAD SILOSHEATH in view of Ihle et al., DE 43 21 182 C1. To incorporate a docking means into the SILOPAD structure in the manner taught by Ihle et al. would have been obvious in order to impart a more stable securement with the limb prosthesis, with motivation having been provided by the similarities in design of the two products and by the advantages of the docking means in effecting "pre-tension at the prosthesis mounting coupling" (English abstract of DE 43 21 182 C1, last two lines), etc.

The Applicant's remarks have been reviewed and are believed to be adequately addressed in the grounds of rejection above. The altered scope of the newly presented claims necessitated the new grounds of rejection. Therefore:

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is (703) 308-2903 and who is generally available Monday through Thursday during most of each day. The supervisor, Corrine McDermott, can be reached at (703) 308-2111. The receptionist's phone number is (703) 308-0858, and the main FAX numbers are (703) 305-3591, 3590.

dhw: D. Willse
January 10, 2001


DAVE WILLSE
PRIMARY EXAMINER
ART UNIT 3738